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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,399	07/25/2001	Chiaki Matano	211861US3	3527
22850	7590	05/21/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				RODRIGUEZ, RUTH C
ART UNIT		PAPER NUMBER		
3677				

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application N .	Applicant(s)	
	09/911,399	MATANO, CHIAKI	
	Examiner	Art Unit	
	Ruth C Rodriguez	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 30 January 2004.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2-6,9-12 and 14-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 2-6,9-12 and 14-20 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 25 July 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

2. Claims 14, 15 and 18 are objected to because of the following informalities:

- Claim 14, recites “said band comprising a uniform thickness about the entire circumference of said band”. This limitation fails to represent the disclosed invention because the first ditch portion and the second ditch portion do not have a uniform thickness when compared to the third portion and the fourth portion.
- Claim 15, recites “said band comprising an uniform thickness about the entire circumference of said band”. This limitation fails to represent the disclosed invention because the first ditch portion and the second ditch portion do not have a uniform thickness when compared to the third portion and the fourth portion.

- Claim 18, recites "said band comprising a uniform thickness about the entire circumference of said band" in line 15. This limitation fails to represent the disclosed invention because the first ditch portion and the plurality of second ditch portions do not have a uniform thickness when compared to the third portion and the fourth portion.

Correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 16, 2-6, 15, 17, 19, 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takagi (GPI Web Client Printout for JP 410075809 A) in view of Japanese Patent Document JP 07289321 (JP '321).

Takagi discloses a ring comprises a band (1), a first stone (2) and a second stone (3). The band consists essentially of a first portion (mounting for 2), a second portion (mounting of 3) facing the first portion, a third portion (left side of band between mountings for 2 and 3) and a fourth portion (right side of band between mountings for 2 and 3) each being between the first portion and the second portion. The first portion and the second portion face each other (Fig. 1). The first stone is fitted into the first portion and the second stone that differs in material from the first stone and is fitted into the second portion (Fig. 1). The third portion and the fourth portion do not have any

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ditch portion and any stone arranged therein and only a single stone is fitted into the first portion (Fig. 1). Takagi fails to disclose that the first portion has a first ditch portion such that an exposed outer surface of the first stone does not jut from the first ditch portion and the second portion has a second ditch portion such that an exposed outer surface of the second stone does not jut from the second ditch. However, JP '321 teaches a ring comprised of a band and a first stone. The band has a mounting portion (mounting for 2) and a second portion (rest of the band). The mounting portion has a first ditch portion (3) formed from an outer surface thereof toward an inside thereof. Only a single stone is fitted into the first ditch portion. An exposed outer surface of the first stone does not jut from the first ditch portion (Fig. 2). The first ditch portion disclosed by JP '321 provides a high degree of manufacturing efficiency (Abstract) and provides a secure mounting for the stone because the exposed surface of the stone does extend beyond the mounting. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a ditch portion provided in the mounting portion where an exposed surface of the stone does not jut from the ditch portion as taught by JP '321 in the ring disclosed by Takagi where the first portion has a first ditch portion formed in the outer surface thereof toward an inside thereof and a second portion has a second ditch portion formed from an outer surface thereof toward an inside thereof such that an exposed outer surface of a single first stone does not jut from the first ditch portion and an exposed outer surface of a single second stone does not jut from the second ditch portion. Doing so, provides a high

degree of manufacturing efficiency and provides a secure mounting for the stone because the exposed surface of the stone does extend beyond the mounting.

JP '321 discloses that the ring further comprises a central axis. The central axis connects a center of a bottom surface of the ditch portion and a center of curvature of both an outer surface of the ring and an inner surface of the ring (Fig. 2-4). Therefore from the combination of Takagi and JP '321, it would have been obvious to one having ordinary skill in the art at the time the invention was made that a first central axis could connect a center of a bottom surface of the first ditch portion and a center of curvature of both an outer surface of the ring and an inner surface of the ring and a second central axis could connects a center of a bottom surface of the second ditch portion and the center of curvature of both the outer and inner surfaces of the ring in accordance with the teaching of JP '321 in the ring disclosed by Takagi where The first central axis is separated from the second central axis by an angle of approximately 180 degrees , as disclosed by Takagi, in order for the first ditch portion and the second ditch portion to be arranged so that when the ring is put on any finger of a hand of a wearer of the ring except a thumb and a little finger thereof in such a manner that the outer surface of the first stone is on a back of the hand of the wearer of the ring and the outer surface of the second stone is on a palm side of the hand of the wearer of the ring and not seen from the back of the hand of the wearer of the ring (Fig. 2). When the ring is put on the any finger of the hand of the wearer of the ring except the thumb and the little finger thereof in such a manner that the outer surface of the second stone is on the back of the hand

of the wearer of the ring, the outer surface of the first stone is on the palm side and not seen from the back of the hand of the wearer of the ring (Fig. 2).

Takagi also discloses that:

The first stone could be a diamond (Solution).

The second stone could be a sapphire (Solution).

The second stone could be a ruby (Solution).

The second stone could be an emerald (Solution).

The band has a uniform thickness about an entire circumference of the band (Fig. 1).

Takagi also discloses that only a single stone is fitted into the second portion. Therefore from the combination of Takagi and JP '321, a single stone is fitted into the second ditch portion since JP '321 teaches that the ditch portion only receives a single stone.

The second portion has a second ditch portion formed from the outer surface thereof toward an inside thereof. The first ditch portion and the second ditch portion facing each other. An exposed outer surface of the first stone does not jut from the first ditch portion. An exposed outer surface of the second stone does not jut from the second ditch portion.

Takagi disclose a ring comprises a band (1), a first stone (2) and a second stone (3). The band comprises a first portion (mounting for 2), a second portion (mounting for 3) facing the first portion, a third portion (left side of band between mountings for 2 and 3) and a fourth portion (right side of band between mountings for 2 and 3) each being

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between the first portion and the second portion. The second portion faces the first portion (Fig. 1). The first stone fitted into the first portion and the second stone that differs in material from the first stone and is fitted into the second portion (Fig. 1). The third portion and the fourth portion do not have any ditch portion and any stone arranged therein and only a single stone is fitted into the first portion (Fig. 1). Takagi fails to disclose that the first portion has a first ditch portion such that an exposed outer surface of the first stone does not jut from the first ditch portion and the second portion has a second ditch portion such that an exposed outer surface of the second stone does not jut from the second ditch. However, JP '321 teaches a ring comprised of a band and a first stone. The band has a mounting portion (mounting for 2) and a second portion (rest of the band). The mounting portion has a first ditch portion (3) formed from an outer surface thereof toward an inside thereof. Only a single stone is fitted into the first ditch portion. An exposed outer surface of the first stone does not jut from the first ditch portion (Fig. 2). The first ditch portion disclosed by JP '321 provides a high degree of manufacturing efficiency (Abstract) and provides a secure mounting for the stone because the exposed surface of the stone does extend beyond the mounting. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a ditch portion provided in the mounting portion where an exposed surface of the stone does not jut from the ditch portion as taught by JP '321 in the ring disclosed by Takagi where the band has a first ditch portion formed from an outer surface of the first portion toward an inside of the first portion and a second ditch portion formed from an outer surface of the second portion toward an inside of the

second portion with a first stone fitted into the first ditch portion and a second stone that differs in material from the first stone and is fitted into the second ditch portion where an exposed outer surface of the first stone does not jut from the first ditch portion and an exposed outer surface of the second stone does not jut from the second ditch portion. Doing so, provides a high degree of manufacturing efficiency and provides a secure mounting for the stone because the exposed surface of the stone does extend beyond the mounting.

4. Claims 18 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '321 in view of German Patent Document G 87 04 923.6 (G '923.6).

JP '321 discloses a ring comprises a band (1) and a stone (2). The band consists essentially of a first portion (mounting for 2) and a remaining portion (rest of the band). The first portion has a first ditch portion (3) formed from an outer surface thereof toward an inside thereof. The stone is fitted into the first ditch portion, wherein an exposed outer surface of the stone does not jut from the first ditch portion (Figs. 2-4). The remaining portion does not have any ditch portion and any stone arranged therein (Figs. 2-4). Only a single stone is fitted into the first ditch portion and the band has uniform thickness about an entire circumference of the band (Fig. 2). JP '321 fails to disclose that the band has a second portion, a third portion and a fourth portion where the second portion has a plurality of second ditch portions forming a person's initials. However, G '923.6 teaches a ring comprising a first portion (3), a second portion (2) facing the first portion (Fig. 1), a third portion (left side of band between portions for 2 and 3) and a fourth portion (right side of band between portions 2 and 3) each being

between the first portion and the second portion (Fig. 1). The second portion has a plurality of second ditch portions formed from the outer surface thereof toward an inside thereof and arranged separately from each other along the outer surface of the second portion (Fig. 2). The plurality of second ditch portions form a person's initials recognized when seen from above (Fig. 2). The third portion and the fourth portion do not have any ditch portion and any stone arranged therein. The ring disclosed by G' 923.6 provides more variety and also helps to prevent loss of a ring because the initials on the ring will identify the user thereby providing an additional means to identify an user as the owner of the ring. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second portion, a third portion and a fourth portion of a band where the second portion is provided with a plurality of ditch portions as taught by G '923.6 in the ring disclosed by JP '321. Doing so, will provide a ring with more ornamental variety and will also help to prevent loss of a ring because the initials on the ring will identify the user thereby providing an additional means to identify an user as the owner of the ring.

JP '321 discloses that the ring further comprises a central axis. The central axis connects a center of a bottom surface of the ditch portion and a center of curvature of both an outer surface of the ring and an inner surface of the ring (Fig. 2-4). Therefore from the combination of JP '321 and G '923.6, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the ring will further comprises a first central axis which connects a center of a bottom surface of the first ditch portion and a center of curvature of both an outer surface of the ring and an inner

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surface of the ring as disclosed by JP '321 and a second central axis which connects a center of a bottom surface of the plurality of second ditch portions and the center of curvature of both the outer and inner surfaces of the ring, where the first central axis is separated from the second central axis by an angle of approximately 180 degrees as taught by G '923.6 in order for the first ditch portion and the plurality of second ditch portions to be arranged so that when the ring could be put on any finger of a hand of a wearer of the ring except a thumb and a little finger thereof in such a manner that the outer surface of the stone could on a back of the hand of the wearer of the ring and the initials are on a palm side and could not be seen from the back of the hand of the wearer of the ring and that when the ring could be put on any of finger of a hand of a wearer of the ring except the thumb and the little finger thereof in such a manner that the initials could be on the back of the hand of the wearer of the ring, the outer surface of the stone could on the palm side and not seen from the back of the hand of the wearer of the ring (by using an arrangement similar to the one shown in Fig. 1 of G '923.6). Doing so, will provide a ring with more ornamental variety and will also help to prevent loss of a ring because the initials on the ring will identify the user thereby providing an additional means to identify an user as the owner of the ring.

For claims 9-12, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to have a diamond, a sapphire, a ruby and an emerald, respectively for claims 9-12, as the stone since the Examiner takes Official Notice of the use of diamonds, sapphires, rubies and emeralds in jewelry and the

selection of any of these known stones to use would be within the level of ordinary skill in the art.

Response to Arguments

5. Applicant's arguments filed 30 January 2004 have been fully considered but they are not persuasive.

6. Regarding claims 16 and 19, the Applicant argues that for the combination of JP '321 in view of Takagi, JP '321 fails to disclose the second ditch portion and the second stone and that Takagi recites that at least one of the two ornaments is a lumpish object that is attached in a manner protruding outward from the ring section. The Examiner fails to be persuaded by these arguments. In order to better illustrate the Examiners position, a new rejection using the same references was made but more clearly illustrating the intentions of the Examiner. The Examiner's intentions were not to take the entire teachings of Takagi into ring disclosed by JP '321. Instead, the Examiner intention was to only take the teaching that providing two stones offset from each other in a ring is well known in the art. The newly recited rejection better illustrates this combination by using Takagi as the base reference and substituting the mounting of the two stones with the mounting taught by JP '321. Such will provide high degree of manufacturing efficiency, as taught by JP '321, and will also provides a secure mounting since the stone protruding outward from the ring is more prone to be lost than a stone whose exposed surface is jut within the ditch portion because the exposed surface of

the stone does extend beyond the mounting and could not be accidentally caught in another object.

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the first ditch portion and the second ditch portion are both non-penetrating portions and cannot be seen at all from the inner side of the first portion and the second portion respectively) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. Regarding to claim 18, the arguments presented by the Applicant are directed to the fact that the band has a uniform thickness about an entire circumference of the band where JP '321 and G' 923.6 fail to show this feature. This argument fails to persuade. In the first place the Examiner has objected to this limitation because as clearly shown in Applicant's invention, the band fails to have a uniform thickness about the entire circumference of the band because the first ditch portion and the second ditch portion are areas where the thickness is being reduced in order to provide a mounting surface for the first stone and the second stone. Therefore, JP '321 can also be interpreted as having this limitation if the Applicant believes that his ring has a uniform thickness about the entire circumference of the band. However, even if the Applicant where to amend the claim to more clearly describe his invention, the Examiner reminds the Applicant that the specifications and the drawings do not provide any advantages derived from having a ring with a uniform thickness, as now cited, and that the Examiner can use a

design choice rejection based on change in shape or could also use another reference providing an advantage of having “a uniform thickness” for the ring in order to reject this limitation.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (703) 308-1881. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (703) 306-4115.

Submissions of your responses by facsimile transmission are encouraged. Technology center 3600's facsimile number for before and after final communications is (703) 872-9306. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase the patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as PTO's mailroom processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP § 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee that the applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP § 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 872-9306) on (Date).
(Typed or printed name of person signing this certificate)
(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP § 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response has been transmitted by facsimile will cause further unnecessary delays in the processing of your application, duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

RCR
rcr
May 17, 2004